

**REMARKS**

In a restriction requirement dated December 20, 2005, the Examiner required restriction under 35 U.S.C. § 121 between the following two Groups:

Group I: Claims 1-12, 17-20, 25, 27-37, 49, 51-61, and 73 as allegedly drawn to a method of making a tooling for a composite structure, classified in class 156, subclass 173; and

Group II: Claims 13-16, 21-24, 26, 38-48, 50, 52-72, and 74 as allegedly drawn to a system for making tooling for composite manufacture, classified in class 156, subclass 425.

In the restriction requirement, the Examiner indicated that Group II included claims 52-72, even though claims 52-61 were also included in Group I. Based on the Examiner's description of Groups I and II, Applicant has assumed that this was a typographical error and that only claims 62-72 were intended to be included in Group II.

In addition, Applicant also notes that claim 17 included a typographical error indicating that it is dependent on claim 1. As is apparent from the preamble of that claim, however, claim 17 is an apparatus claim and was intended to be dependent on claim 13. Applicants have amended claim 17 to clarify that it is dependent on claim 13.

For these reasons, and based on this amendment, Applicant believes that the claims should be grouped as follows:

Group I: Claims 1-12, 25, 27-37, 49, 51-61, and 73; and

Group II: Claims 13-24, 26, 38-48, 50, 62-72, and 74.

For purposes of this response, Applicants have proceeded according to this grouping.

Additionally, in the restriction requirement, the Examiner stated that the application “contains claims directed to . . . patentably distinct species of the claimed invention.” (Restriction Requirement at 3.) Therefore, the Examiner required that Applicant elect a single disclosed species for prosecution on the merits. The Examiner also indicated that claims 1-5, 9-17, 21-30, 34-41, 45-55, 59-66, and 70-74 are generic.

For the reasons set forth below, Applicants respectfully traverse the restriction and election requirements.

### **Restriction Between Groups I and II**

Applicant respectfully traverses the Examiner’s restriction requirement between Groups I and II. The Examiner argues that the methods of Group I and the apparatus of Group II are distinct because the methods of Group I could be practiced with a materially different apparatus from those of Group II. In support, the Examiner states that the process as claimed could be manufactured with an apparatus that includes only “a single filling component wherein the same filling component was used to fill the first contained volume with granular material and then the same filling component was used to fill the tooling with granular material therein.” (Restriction Requirement at 2.) The Examiner has provided no evidence, however, that Applicant’s claimed apparatus is materially different from an apparatus having a single filling component. Absent a showing of material difference, the restriction requirement is improper. MPEP § 806.05(e). Therefore, the inventions of Groups I and II are not distinct on this basis.

Moreover, there must be a serious burden on the Examiner to examine the claims in one application in order for restriction to be appropriate. MPEP § 803. The claims of Groups I and II would not require substantial additional searching by the

Examiner due to the similarity in the claims. For example, claim 1 of Group I recites: "A method of filling a tooling with a granular media, comprising: filling a contained volume with a first granular media; attaching the contained volume in a portion of the tooling; and filling the tooling with a second granular media," while claim 13 of Group II recites: "An apparatus for filling a tooling with a granular media, comprising: a first filling component configured to fill a contained volume with a first granular media; an attaching component configured to attach the contained volume in a portion of the tooling; and a second filling component configured to fill the tooling with a second granular media." The similarity of these claims demonstrates that no serious burden exists in examining these claims together.

In addition, the Examiner has classified all of the claims in the same class, i.e., class 156. Because the Examiner has not shown separate classification or separate fields of search, Applicants submit that no serious burden would result from examining all of the claims together. "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits...." MPEP § 803.

Finally, requiring restriction would result in unnecessary delay in examination and added cost to Applicants.

Therefore, Applicants respectfully request that the Examiner withdraw the restriction requirement between Groups I and II.

### **Restriction Between Species**

Applicant also respectfully traverses the Examiner's requirement that Applicant elect a species of claims directed to a specific material for the porous bag limitation of

the claims. In the restriction requirement, the Examiner stated that the “various species of the material used to make the porous bag material of the flexible bags including fiberglass cloth weave, metallic screen, and plastic film” were patentably distinct. (Restriction Requirement at 3.) The Examiner, however, has not provided any basis for this conclusion. The MPEP requires that:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

MPEP § 808.01. Because the Examiner has provided only a conclusion as to the alleged distinctness and has not provided any reasons for this conclusion, restriction to a single species is improper. Moreover, Applicant cannot properly respond to the Examiner’s restriction requirement absent an explanation as to why the Examiner believes the species are patentably distinct. Therefore, Applicant respectfully requests that the requirement that Applicant elect one species of the invention be withdrawn.

#### **Election of Group and Species**

Should the Examiner continue to assert that the inventions of Group I and Group II are distinct, but agree that the requirement of election between species is improper, Applicants provisionally elect to prosecute Group I, claims 1-12, 25, 27-37, 49, 51-61, and 73.

Should the Examiner agree that restriction between Groups I and II discussed above is improper, but continue to assert that the requirement of election between species is proper, Applicants provisionally elect to prosecute generic claims 1-5, 9-17,

21-30, 34-41, 45-55, 59-66, and 70-74, and species claims 6, 18, 31, 42, 56, and 67 directed to a porous fabric formed of a fiberglass cloth weave.

Should the Examiner continue to assert that the inventions of Group I and Group II are distinct and that the requirement of election between species is proper, Applicants provisionally elect to prosecute Group I generic claims 1-5, 9-12, 25, 27-30, 34-37, 49, 51-55, 59-61, and 73, and Group I species claims 6, 31, and 56 directed to a porous fabric formed of a fiberglass cloth weave.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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